

Serial No. 09/158,728

**PATENT**

Avery No. 2419-US

Old Docket No. 310048-355

Atty Docket No.: 11286-01083

**REMARKS/ARGUMENTS**

In the above-mentioned Office Action, claims 479-531 were rejected as failing to comply with the written description requirement; claims 479, 481, 495, 498, 499, 524, 528 and 529 were rejected as being anticipated by U.S. Patent 3,420,364 (Kennedy); claims 479, 481, 484, 485, 491, 499, 505, 507, 524, 528 and 529 were rejected as being anticipated by U.S. Patent 5,466,013 (Garrison); claims 479-514 and 524-529 were rejected as being unpatentable over U.S. Patent 4,863,772 (Cross) in view of U.S. Patent 5,407,718 (Popat); claims 515 and 516 were rejected as being unpatentable over Cross in view of Popat and further in view of U.S. Patent 4,704,317 (Hickenbotham); claims 517-523 were rejected as being unpatentable over Cross in view of Popat and further in view of U.S. Patent 5,198,275 (Klein); and claims 530 and 531 were rejected as being unpatentable over Cross in view of Popat and further in view of U.S. Patent 5,842,722 (Carlson)

"Carrier" has been deleted from the claims in response to the written description rejection.

Independent claim 479 has been amended to further define the facestock sheet construction. Dependent claims 485, 490, 500, 505, and 507 have been accordingly cancelled, and claims 489, 507, 508 512 and 524 have been amended. Dependent claims 534 and 535 have been added.

Claim 508 has been amended to correctly recite the dimensions.

Independent claim 479 has been further amended to state that the (non-tacky) back sides of the individual printed business cards are formed by the film layer. Dependent claim 528 has accordingly been cancelled.

Kennedy does not disclose the facestock sheet construction as presently claimed. (See, e.g., Kennedy, column 1, lines 62-67). Further, the printable business card sheet of the present invention is easier to cut than the Kennedy tag strip. (See, e.g., Kennedy, column 2, lines 35-45.)

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Garrison does not disclose the facestock sheet construction and the continuous sheet as presently claimed.

Applicants respectfully contend that the obviousness rejections of Cross in view of Popat were improper.

According to the embodiment of Cross relied upon by the Examiner in her rejections, the (1) dry laminate material in roll form is (2) printed with non-variable information by the manufacturer, (3) the labels are then die cut on the roll, (4) the matrix surrounding the die cut non-adhesive labels is then removed, (5) the web is then cut to the desired length, (6) the cut web is then fan folded (again with the matrix removed), and (7) the fan folded web is then delivered to the end user who runs it through his tractor-feed printer to print desired variable indicia on the non-adhesive labels. The printed non-adhesive labels are subsequently removed. The perforation lines likely can be made before step (2) above, and the small tractor feed holes likely can be die cut between steps (4) and (5).

Popat is very different from Cross. First, Popat discloses an adhesive label (see adhesive 30 in Popat FIG. 1) which inherently has a very different purpose, use and construction than the non-adhesive labels of Cross. (In contrast to Cross, the non-adhesive portion of Popat is the backing layer 28.) Thus, there is no suggestion to modify Cross in view of Popat. See, e.g., In re Kotzab, 217 F.3d 1365, 55 USPQ 2d 1313 (Fed. Cir. 2000). (Also, the mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. See, e.g., In re Fritch, 972 F.2d 1260, 23 USPQ 2d 1780 (Fed. Cir. 1992); and In re Mills, 916 F.2d 680, 16 USPQ 2d 1430 (Fed. Cir. 1990).) Second, Popat is not fan folded and thus has a very different purpose, use and construction than the fan folded construction of Cross. Third, to modify Cross so that the matrix has not been removed when the end user prints on the non-adhesive labels is contrary to a primary purpose of Cross. See, e.g., In re Gordon, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). This primary purpose being to allow

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the printed non-adhesive labels to be quickly accessed and removed without an adjacent interfering matrix (See, e.g., FIG. 1(c)).

It is thus not seen why one would modify Cross in view of Popat except with the use of impermissible hindsight as the Examiner has done. See, e.g., *In re Lee*, 277 F.3d 1338, 61 USPQ 2d 1430 (Fed. Cir. 2002). More particularly, Applicants respectfully contend that the Examiner in her rejections is simply picking and choosing elements from Popat and then combining them with elements from Cross. In making an obviousness rejection, the Examiner is not permitted to "pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." *In re Fine*, 837 F.2d 1071, 5 USPQ 2d 1596 (Fed. Cir. 1988).

Claim 479 claims that the dry laminate sheet construction is sized, constructed and adapted to be sheet-fed through a printer or copier for a printing operation on the printable business cards. Further, a top surface of the facestock sheet construction is constructed and adapted to receive indicia printed on the top surface during the printing operation.

The Examiner at the bottom of page 8 of her action stated that the dry laminate sheet construction of Cross is "sized, constructed and adapted to be sheet-fed through a printer or copier for a printing operation..." This is an incorrect reading of Cross, Applicants respectfully contend. Rather, Cross discloses a "construction" that is not so sized, constructed and adapted to be sheet-fed through a printer or copier... That is, Cross discloses the opposite, namely, a construction which is printed while in a roll (or web or web-like) form. See, e.g., Cross, column 4, lines 48-58, column 5, lines 50-57, and column 6, lines 35-49.

Claim 479 has been amended to include that the facestock sheet is a cardstock sheet (and dependent claim 507 has been cancelled). This is contrary to the adhesive (flexible) paper labels of Popat.

The arguments in Applicants' Amendment dated September 19, 2005 and in the Amendment dated January 24, 2005 regarding lay-flat and remoisturization are

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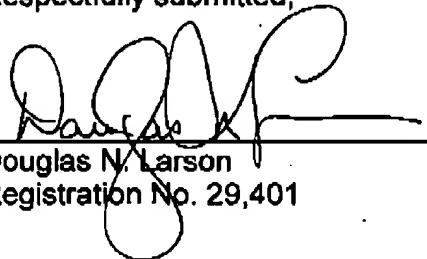
incorrect and are hereby withdrawn. The below-signed counsel first learned that those arguments were incorrect after the filing of the September 19, 2005 Amendment.

Accordingly, it is respectfully contended that all of the claims now pending are in condition for allowance. Issuance of the Notice of Allowance at an early date is thus in order.

If there are any remaining issues, the Examiner is encouraged to telephone the below-signed counsel for Applicants at (213) 689-5142 to seek to resolve them.

The Commissioner is hereby authorized to charge any additional fees which may be required, or credit any overpayment to Deposit Account No. 07-1853. Should such additional fees be associated with an extension of time, Applicants respectfully request that this paper be considered a petition therefor.

Respectfully submitted,

  
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